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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,616	03/06/2001	Laurent Gauche	PF980061	3464

24498 7590 07/21/2004

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EXAMINER

AKPATI, ODAICHE T

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/786,616

Applicant(s)

GAUCHE, LAURENT

Examiner

Tracey Akpati

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Rix et al (6385317 B1).

With respect to Claim 1, the limitation of “at least one device intended to read and/or write data from/to a detachable security element supplied by a service provider” is met on column 1, lines 12-16 and 35-40. The decoder represents the device and the smart card represents the detachable security element. The limitation of “filters intended to select at least one message for managing entitlements which a user possesses with regard to a service supplied by said provider from among a data stream” is met inherently on column 2 lines 33-38. The filters within the decoder select the EMM pertaining to that particular smart card. The limitation of “means for selecting an entitlement message intended for a detachable security element when said security element is not inserted in the decoder” is met on column 2, lines 34-38; and “means for storing said entitlement management message” is met on column 2, lines 36-38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the filters select a message for managing entitlements because receipt of the EMM at the inserted security element allows for access to the secure content.

With respect to Claim 5, the limitation of “in which the detachable security element is a smart card” is met by the abstract.

Claims 2, 3, 4, 8 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Rix et al (6385317 B1) in view of Campinos et al (EP0817485 A1) in further view of Thatcher (5937067).

With respect to Claim 2, Rix et al meets the limitation of “reinstalling, following erasure of the configuration of filters consequent upon the removal of said security element, the stored configured of filters which is appropriate to said security element, in such a way as to select an entitlement management message intended for said security element when the latter is removed” inherently on column 3, lines 7-15. Hence when the card is reinserted, the filter configuration is reinstalled because the previous configuration has been erased, preventing any further communication with the decoder. Hence the configuration process has to be repeated for the smart card to be able to re-download the EMM and then allow the data to be accessed. Rix et al does not meet the following limitation.

Campinos et al meets the limitation of “receiving an identification parameter contained in a security element inserted into said decoder; and installing a filter configuration as a function of the identification parameter received in such a way as to select an entitlement management message intended for said inserted security element” on column 3, lines 9-28, 54-58 and column 4, lines 1-4. The installing of the filter configuration includes utilizing the smart card address and pid (inherently in header of EMM) transmitted to the filter in order to allow the filter to

select the corresponding EMM for the given smart card. Campinos et al meets the limitation of “a module for storing entitlements capable of storing said configuration of filters which is installed by the access control module” on column 5, lines 8-11. The combination of Rix et al and Campinos et al does not explicitly disclose the following.

The limitation of “storing said message in a memory of said decoder” is met by Thatcher on column 4, lines 48-50 and 54-57.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Thatcher within the combination of Rix et al and Campinos et al so as to be able to have a copy of the EMM at the decoder to allow for fast and easy retrieval.

With respect to Claim 3, all the limitation is met by the combination of Rix et al and Campinos et al except for the following limitation. Thatcher meets the limitation of “detecting the insertion of a security element into said decoder” inherently on column 9, lines 21-25; and “verifying whether an entitlement management message intended for said inserted security element is stored in the memory of the decoder; and should verification be positive, transmitting said stored message to said inserted security element” is met on column 4, lines 41-58, 21-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Thatcher within the combination of Rix et al and Campinos et al because reception of the EMM at the inserted security element allows for access to the secure content.

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With respect to Claim 4, all the limitation is met by the combination of Rix et al and Campinos et al except for the following limitation. The limitation of “in which the module for storing entitlements detects the insertion of a security element into the decoder by recording any new installing of configuration filters by the access control module” is met by Thatcher on column 4, lines 54-58.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Thatcher within the combination of Rix et al and Campinos et al because reception of the EMM at the inserted security element allows for access to the secure content.

With respect to Claim 8, all the limitation is met by the combination of Rix et al and Campinos et al except for the following limitation.

The limitation of “wherein it comprises an additional step consisting in storing in a memory of the decoder said entitlement management message intended for said removed security element when such a message is selected” is met by Thatcher on column 4, lines 54-57.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Thatcher within the combination of Rix et al and Campinos et al because reception of the EMM at the inserted security element allows for access to the secure content.

With respect to Claim 9, all the limitation is met by the combination of Rix et al and Campinos et al except for the following limitation.

Thatcher meets the limitation of “reinserting said security element into the decoder” on column 9, lines 21-25; and “verifying whether an entitlement management message intended for said inserted security element is stored in the memory of the decoder” inherently on column 4, lines 41-58; and “should verification be positive, transferring the stored message to said inserted security element” on column 4, lines 21-25.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Thatcher within the combination of Rix et al and Campinos et al because reception of the EMM at the inserted security element allows for access to the secure content.

Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Rix et al (6385317 B1) in view of Campinos et al (EP0817485 A1).

With respect to Claim 6, all the limitation is met by Rix et al except for the following limitation.

The limitation of “in which the identification parameter contained in the security element is the address of the smart card” is met by Campinos et al on column 4, lines 1-4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Campinos et al within the system of Rix et al because identification parameter of the smart card is necessary for the decoder determination of the appropriate EMM for the smart card.

Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Rix et al (6385317 B1) in view of Campinos et al (EP0817485 A1).

With respect to Claim 7, Rix et al meets the limitation of “transmitting said message to said inserted security element wherein the step of installing the configuration of filter which is appropriate to said security element is followed by a step of storing said configuration” on column 2, lines 11-13, 33-38. The storing of the configuration is inherent when the EMM is being selected by the filters for the smart card. Rix et al meets further limitation of “and in that when said security element is removed from the decoder, causing the erasure of said configuration of filters, the configuration of filters which is appropriate to the removed security element is reinstalled on the basis of the configuration stored during the storage step in such a way as to select an entitlement management message intended for said removed security element” inherently on column 3, lines 7-15. This is because when another card is inserted, there can be no communication possible, but if the card is reinserted communication resumes. Rix et al however does not meet the following limitation.

Campinos et al meets the limitation of “inserting a detachable security element into a decoder” inherently on column 3, lines 9-23; and “recovering from said security element an identification parameter” on column 4, lines 1-4; and “installing a configuration of filter of the decoder as a function of said identification parameter in such a way as to select an entitlement management message intended for said inserted security element” on column 3, lines 9-28, 54-58 and on column 4, lines 1-4.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Campinos et al within the system of Rix et al because an



identification parameter of the smart card is necessary for the calculation of the EMM at the decoder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracey Akpati whose telephone number is 703-305-7820. The examiner can normally be reached on 8.30am-6.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OTa

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